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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,680	07/30/2003	Kristian Hammond	08803-024	6562

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McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER
SETLAK, ANDREW T

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/629,680</td><td>Applicant(s)
HAMMOND ET AL.</td><td></td></tr>
<tr><td>Examiner
Andrew Setlak</td><td>Art Unit
2166</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) *10,11 and 14-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 & 12-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *7/30/2003*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election, with traverse, of invention 1 consisting of claims 1-9, 12 & 13 via a written response to the election/restriction requirement mailed on 2/28/2006 has been received and accepted. However, applicant's arguments with regards to including claims 25 & 26 are not found to be persuasive, by asserting that claims 25 & 26 contain further limitations of claim 1 the applicant is admitting that the scope of the inventions is not identical and as such restriction is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the methods of the instant application must be shown in a flowchart or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 3 is objected to because of the following informalities: On line 2 of claim 3 the word "locating" does not appear to conform with proper idiomatic English, the phrase "being located" would be more clear. Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 101

Claims 1-9 & 12-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be

statutory it must produce a useful, concrete *and* tangible result. Claims 1-9 & 12-13 do not appear to produce a tangible result which enables the asserted usefulness, merely performing a computations does not constitute a tangible result, in order for a result to be considered tangible it must be embodied on some physical medium which enables the asserted usefulness to be realized. Appropriate clarification of correction is required.

Claims 9 & 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In light of ¶ [0054] of the specification claims 9 & 13 include within their scope the non-statutory subject matter of signals embodied within a transmission medium. Thus, claims 9 & 13 are rejected under 35 U.S.C. §101 as being directed to the non-statutory area of signals embodied on a transmission medium.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in

order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The

three product classes have traditionally required physical structure or material.

"The term machine includes every mechanical device or combination of

mechanical device or combination of mechanical powers and devices to perform some

function and produce a certain effect or result." Corning v. Burden, 56 U.S. (15 How.)

252, 267 (1854). A modern definition of machine would no doubt include electronic

devices which perform functions. Indeed, devices such as flip-flops and computers are

referred to in computer science as sequential machines. A claimed signal has no

physical structure, does not itself perform any useful, concrete and tangible result and,

thus, does not fit within the definition of a machine.

A "composition of matter" "covers all compositions of two or more substances

and includes all composite articles, whether they be results of chemical union, or of

mechanical mixture, or whether they be gases, fluids, powders or solids." Shell

Development Co. v. Watson, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C.

1957), aff'd, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958). A claimed signal is not

matter, but a form of energy, and therefore is not a composition of matter.

The Supreme Court has read the term "manufacture" in accordance with its

dictionary definition to mean "the production of articles for use from raw or prepared

materials by giving to these materials new forms, qualities, properties, or combinations,

whether by hand-labor or by machinery." Diamond v. Chakrabarty, 447 U.S. 303, 308,

206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v. Brogdex Co.,

283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which, in turn, quotes the Century Dictionary).

Other courts have applied similar definitions. See American Disappearing Bed Co. v.

Arnaelsteen, 182 F. 324, 325 (9th Cir. 1910), cert. denied, 220 U.S. 622 (1911). These

definitions require physical substance, which a claimed signal does not have. Congress

can be presumed to be aware of an administrative or judicial interpretation of a statute

and to adopt that interpretation when it re-enacts a statute without change. Lorillard v.

Pons, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been

aware of the interpretation of manufacture in American Fruit Growers when it passed

the 1952 Patent Act.

A manufacture is also defined as the residual class of product. 1 Chisum, §

1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)).

A product is a tangible physical article or object, some form of matter, which a

signal is not. That the other two product classes, machine and composition of matter,

require physical matter is evidence that a manufacture was also intended to require

physical matter. A signal, a form of energy, does not fall within either of the two

definitions of manufacture. Thus, a signal does not fall within one of the four statutory

classes of § 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

Claims 1-9 & 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by the article entitled *How to Search a WAIS Database* (henceforth referred to as WAIS).

Claim 1 is anticipated by WAIS as follows: **An adaptive method for obtaining representative text items from a plurality of text items in an active task, each of the plurality of text items having a plurality of attributes, the method comprising the steps of: (a) for each of the plurality of text items, identifying each of the plurality of attributes** (page 2, § Word Weight)**; (b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights** (page 2, § Word Weight)**; (c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality of attributes** (page 2, § Relevance Ranking)**; and (d) ranking the plurality of text items based on the accumulated weight of each of the plurality of text items** (page 2, § Relevance Ranking).

Claim 2 is anticipated by WAIS as in claim 1, **wherein the plurality of attributes includes at least one of style, font size, and location of the text item** (page 2, § Word Weight).

Claim 3 is anticipated by WAIS as in claim 2, **wherein a weight assigned to a word is increased in response to the word locating in a specific region** (page 2, § Word Weight).

Claim 4 is anticipated by WAIS as in claim 3, **wherein the specific region is an active window being viewed by a user or a region selected by the user** (page 2, § Fielded Search, wherein the user selects a field [region] to search within).

Claim 5 is anticipated by WAIS as in claim 1, **further forming a plurality of search terms based on a result of the ranking step** (page1, § Natural Language; page 3, § Term Weight, wherein the natural language interpreter uses the term weighting associated with each term to create the weighted query).

Claim 6 is anticipated by WAIS as follows: **A data processing system for obtaining representative text items from a plurality of text items in an active task, each of the plurality of text items having a plurality of attributes, the system comprising: a data processor for processing data; a data storage device for storing instructions; and a data transmission path coupled to the data processor and the data storage device** (page 1, § How to Search a WAIS Database, both servers and workstations are comprised of at least: processor[s], storage device[s] & communications bus[ses]; **wherein the instructions, when executed by the data processor, controls the data processing system to perform the machine-implemented steps of: (a) for each of the plurality of text items, identifying each of the plurality of attributes** (page 2, § Word Weight); **(b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights** (page 2, § Word Weight); **(c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality**

of attributes (page 2, § Relevance Ranking); and (d) ranking the plurality of text items based on the accumulated weight of each of the plurality of texts (page 2, § Relevance Ranking).

Claim 7 is anticipated by WAIS as in claim 6, wherein the plurality of attributes includes at least one of style, font size, and location of the text item (page 2, § Word Weight).

Claim 8 is anticipated by WAIS as in claim 6, further forming a plurality of search terms based on a result of the ranking step (page1, § Natural Language; page 3, § Term Weight, wherein the natural language interpreter uses the term weighting associated with each term to create the weighted query).

Claim 9 is anticipated by WAIS as follows: A machine-readable medium bearing instructions for obtaining representative text items from a plurality of text items in an active task, each of the plurality of text items having a plurality of attributes, the instructions upon execution by a data processing system causing the data processing system to perform the steps of: (a) for each of the plurality of text items, identifying each of the plurality of attributes (page 2, § Word Weight); (b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights (page 2, § Word Weight); (c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality of attributes (page 2, § Relevance Ranking); and

(d) ranking the plurality of text items based on the accumulated weight of each of the plurality of texts (page 2, § Relevance Ranking).

Claim 12 is anticipated by WAIS as follows: **A method for retrieving information related to the context of a plurality of text items, wherein each of the plurality of text items has a plurality of attributes, the method comprising the steps of: (a) for each of the plurality of text items, identifying each of the plurality of attributes** (page 2, § Word Weight); **(b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights** (page 2, § Word Weight); **(c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality of attributes** (page 2, § Relevance Ranking); **(d) ranking the plurality of text items based on the accumulated weight of each of the plurality of text items** (page 2, § Relevance Ranking); **(e) generating a set of search terms containing a predetermined number of text items based on rankings of the plurality of text items** (page1, § Natural Language; page 3, § Term Weight, wherein the natural language interpreter uses the term weighting associated with each term to create the weighted query); **and (f) initiating an information retrieval process based on the set of search terms** (page 1, § Natural Language).

Claim 13 is anticipated by WAIS as follows: **A machine-readable medium bearing instructions for retrieving files that are related to the context of a plurality of text items, wherein each of the plurality of text items has a plurality of**

attributes, the instructions upon execution by a data processing system controlling the data processing system to perform the steps of: **(a) for each of the plurality of text items, identifying each of the plurality of attributes** (page 2, § Word Weight); **(b) for each of the plurality of text items, assigning a weight to each of the plurality of attributes, wherein at least two of the plurality of attributes are assigned different weights** (page 2, § Word Weight); **(c) for each of the plurality of text items, calculating an accumulated weight by accumulating the weight assigned to each of the plurality of attributes** (page 2, § Relevance Ranking); **(d) ranking the plurality of text items based on the accumulated weight of each of the plurality of text items** (page 2, § Relevance Ranking); **(e) generating a set of search terms containing a predetermined number of text items based on rankings of the plurality of text items** (page 1, § Natural Language; page 3, § Term Weight, wherein the natural language interpreter uses the term weighting associated with each term to create the weighted query); **and (f) initiating an information retrieval process based on the set of search terms** (page 1, § Natural Language).

Conclusion

The prior art made record of on form PTO-892 and not relied upon is considered pertinent to the applicants' disclosure.

Information Disclosure Statement

Applicants' Information Disclosure Statements, filed on 7/30/2003 have been received, entered into the record, and considered. See attached PTO-1449 forms.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Setlak whose telephone number is (571) 272-4060. The examiner can normally be reached on M-F 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Setlak
Patent Examiner
5/11/2006

Hosain Alam
Supervisory Patent Examiner
AU 2166

MOHAMMAD ALI
PRIMARY EXAMINER